

Remarks/Arguments

The Rejection of Claims 15-19 under 35 U.S.C. § 112

Claims 15-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

At the onset Applicants courteously submit that amended Claim 15 does not introduce any new issues requiring further search/and or consideration as the amendment merely combines Claims 9 and 15 which have been previously examined, and thus, no new limitations are being introduced. Amended Claim 15 clearly sets forth the structural relationship that the recessed portion is a removal panel, thereby obviating the rejection under Section 112, second paragraph.

Similarly, in view of the specification, amended Claim 15 clearly indicates what surface of the recessed portion may be used to grip the microscope. For example, as defined in the specification, “surfaces, recesses and indentations for gripping a microscope are intended to refer to surfaces having sufficient surface areas configured for receiving substantial portions of a individual's hand or portions of the fingers thereon or therein.” (Instant Application, Para. [0018]). Thus, “[r]ecessed portion 36 is sufficiently deep to accept the fingers of an individual ... a hand may be wrapped about the microscope arm and the fingers placed within the recessed portion such that the gripping surface is increased and the gripping force required for securing the microscope, reduced.” (Instant Application, Para. [0021]). Additionally, “walls 40, interior surface 32 and/or inner recess surface 38 may comprise a textured surface, for example a knurled surface, textured painted surface, etc. for increasing the static coefficient of friction thereof such that the force of friction between the recessed portion and hand 46 may be increased.” (Instant Application, Para. [0022]). Furthermore, “recessed portion 36 could be configured to comprise one or more indentations shaped for complementarily receiving a portion of a human hand and/or fingertips.” (Instant Application, Para. [0023]). Moreover, Applicants courteously submit that:

“Figure 2 illustrates that recessed portion 36 is configured to be sufficiently deep such that hand 46 may be wrapped about the microscope arm. When hand 46 is wrapped about the microscope arm, the fingertips may be extended into the recessed portion to apply a gripping force upon inner recess surface 38, walls 40

and interior surface 32, etc. Hence, because the recessed portion provides an increased number of surfaces by which the microscope may be gripped, the effective gripping force required to secure the microscope is reduced when compared with microscopes comprising mere planar arm surfaces. Consequently, the present invention provides a more effective means for securing and gripping a microscope when compared to known microscopes.” (Instant Application, Para. [0025] and Figure 2).

Applicants respectfully assert that amended Claim 15, in view of the specification, clearly indicates what surface and/or surfaces of the recessed portion may be used to grip the microscope.

In view of the foregoing, and in view of the fact that Claims 15-19 have not been rejected over any cited references, Claim 15 is in condition for allowance, and Claims 16-19 are also in condition for allowance due to their dependency from Claim 15. Applicants respectfully submit that reconsideration and withdrawal of this rejection is appropriate and courteously requested.

The Rejection of Claims 9-12, 14, 20-25, 27 and 28 Under 35 U.S.C. § 103(a)

Claims 9-12, 14, 20-25, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 2,135,870 (*Fassin*) in view of United States Patent No. 5,844,714 (*DiResta*) and United States Patent No. 5,556,150 (*Ampel*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants courteously submit that the Examiner has failed to establish a prima facie case of obviousness as there is no suggestion or motivation to combine the cited references. “To establish a prima facie case of obviousness, three basic criteria must be met. *First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.* Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)) (emphasis added).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” M.P.E.P. § 2143.01 (quoting *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)). Applicants respectfully assert that the nature of Applicants’ problem to be solved is quite different than the problems to be solved in *Fassin*, *DiResta* and *Ampel*. *Fassin* is directed at providing: a self-illuminating, enclosed microscope; an improved rotary stage; an adjustable braking and locking means for the rotary stage; and, an improved fine adjustment mechanism for a microscope. (*Fassin*, Col. 1, Lines 1-9). Thus, *Fassin* was solving problems related to microscopes lacking enclosed self-illumination and deficiencies in rotary stages and fine adjustment mechanisms. *DiResta* is directed at a portable microscope, in particular, a small and lightweight device which is portable and useable by children. (*DiResta*, Col. 1, Lines 21-32). Hence, *DiResta* was addressing the problem that microscopes are typically too heavy and/or complicated for children to operate. Lastly, *Ampel* is directed at a probe for detecting and handling objects that are hidden from sight or from which it is desirable to insulate the user from direct contact. (*Ampel*, Col. 1, Lines 21-32). Therefore, *Ampel* solves the problem of a user’s need to search certain concealed areas, *e.g.*, trouser pockets, without the risk of injury or infection due to the presence of certain items in the concealed areas, *e.g.*, hypodermic needles. Contrarily, Applicants’ invention is directed at an improved means for safely transporting a microscope, or in other words, directed at solving the problem of providing a means for transporting a variety of microscopes that does not statically protrude from the microscope stand and does not require complex mechanical means. (Instant Application, Para. [0001] and [0004]).

Additionally, Applicants courteously submit that the teachings of the cited references fail to suggest any desirability of Applicants’ combination of elements, *i.e.*, independent Claims 9 and 20. In other words, the reference teachings, as a whole, solve specific problems wholly unrelated to Applicants’ claimed invention and therefore never touch upon the problems solved by the instant application, nor suggest that it would be desirable to solve such problems. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Moreover, “[a] statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the

references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.” M.P.E.P. § 2143.01 (quoting *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). Thus, Applicants respectfully assert that the cited references’ lack of the combination itself and any suggestion of the desirability of the combination support a finding that the combination of *Fassin*, *DiResta* and *Ampel* does not establish a prima facie case of obvious.

Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention ... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In Re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Similarly, Applicants’ disclosure should not be used in hindsight to infer that the disclosures of *Fassin*, *DiResta* and *Ampel* can be used to arrive at Applicants’ invention as recited in independent Claims 9 and 20. Hence, Applicants courteously assert it is improper to combine *Fassin*, *DiResta* and *Ampel*, and therefore the cited references fail to arrive at the present invention and reconsideration of the rejection is courteously solicited.

As the cited references and the knowledge generally available to one of ordinary skill in the art fail to make some suggestion or motivation to modify the references or to combine reference teachings to arrive at Applicants’ invention, Applicants courteously assert that the Examiner has failed to establish a prima facie case of obviousness. Hence, it generally follows that Claims 9 and 20 are patentable over *Fassin* in view of *DiResta* and *Ampel*. Dependent Claims 10-12, 14 and 28 contain all of the limitations of independent Claim 9, due to their dependency therefrom. Therefore, since Claim 9 is patentable over *Fassin* in view of *DiResta* and *Ampel*, it necessarily follows that Claims 10-12, 14 and 28 are also patentable over *Fassin* in view of *DiResta* and *Ampel*, due to their dependency from Claim 9. Similarly, dependent Claims 21-25 and 27 contain all of the limitations of independent Claim 20, due to their dependency therefrom. Therefore, since Claim 20 is patentable over *Fassin* in view of *DiResta* and *Ampel*, it necessarily follows that Claims 21-25 and 27 are also patentable over *Fassin* in view of *DiResta* and *Ampel*, due to their dependency from Claim 20.

Accordingly, withdrawal of the rejections of Claims 9-12, 14, 20-25, 27 and 28 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

The Rejection of Claims 13 and 26 Under 35 U.S.C. § 103(a)

Claims 13 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fassin* in view of *DiResta* and *Ampel* as applied to Claims 9 and 20 above, and further in view of United States Patent No. 5,406,731 (*Stevens*). Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants courteously assert that as described *supra*, *Fassin*, *DiResta* and *Ampel*, alone or in combination, fail to render independent Claims 9 and 20 unpatentable. Similarly, *Stevens*, being directed at a handgun of improved ergonomic construction, also fails to cure the above described defects, *i.e.*, fails to provide some suggestion or motivation to combine the reference teachings. Thus, independent Claims 9 and 20 are also patentable over *Fassin* in view of *DiResta* and *Ampel* and further in view of *Stevens*.

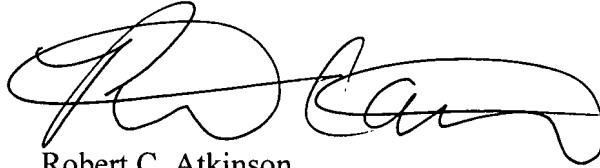
Dependent Claim 13 contains all of the limitations of independent Claim 9, due to its dependency therefrom. Therefore, since Claim 9 is patentable over *Fassin* in view of *DiResta* and *Ampel* and further in view of *Stevens*, due to the lack of suggestion or motivation, it necessarily follows that Claim 13 is also patentable over *Fassin* in view of *DiResta* and *Ampel* and further in view of *Stevens*, due to its dependency from Claim 9. Similarly, dependent Claim 26 contains all of the limitations of independent Claim 20, due to its dependency therefrom. Therefore, since Claim 20 is patentable over *Fassin* in view of *DiResta* and *Ampel* and further in view of *Stevens*, due to the lack of suggestion or motivation, it necessarily follows that Claim 26 is also patentable over *Fassin* in view of *DiResta* and *Ampel* and further in view of *Stevens*, due to its dependency from Claim 20.

Accordingly, withdrawal of the rejections of Claims 13 and 26 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,

A handwritten signature in black ink, appearing to read 'R. C. Atkinson', with a large, stylized loop at the end.

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